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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/927,252	08/10/2001	William R. Stafford	42390P6468C	5547

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EXAMINER

SONG, JASMINE

ART UNIT

PAPER NUMBER

2187

DATE MAILED: 11/28/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

1-10

**Office Action Summary**

Application No.

09/927,252

Applicant(s)

STAFFORD, WILLIAM R.

Examiner

Jasmine Song

Art Unit

2187

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 19-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 19-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## Detailed Action

### Specification

1. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

2. Claims 21-39 have been renumbered as claims 19-37 respectively, and the dependence of claims has been changed accordingly.

### Double Patenting

3. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

4. Claims 19-37 provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-2,4,7-8 and 13 of copending Application No. 09293576.

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This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Regarding independent claims 19, 26 and 32, the subject matter claimed "a plurality of different interfaces to operate the memory device in a plurality of different modes" has been claimed as "a plurality of interfaces to operate the memory device in a plurality of other modes" in the claim 1 in the copend application 09293576.

Regarding claims 20, 27 and 33, the subject matter claimed "a configuration device to select among the plurality of different interfaces" has been claimed as "a configuration circuit to select among the operation interface and the plurality of interfaces" in the claim 1 in the copend application 09293576.

Regarding claims 21,25,29 and 35, the subject matter claimed "test interface ...; a programming interface...; and an operation interface..." has been disclosed in the claim 2 in the copend application 09293576.

Regarding claims 22, 30 and 36, the subject matter claimed "the memory device is a flash memory and the test interface is a standard flash memory interface" has been disclosed in the claim 4 in the copend application 09293576.

Regarding claims 23, the subject matter claimed "the operation interface is a proprietary interface" has been disclosed in the claim 7 in the copend application 09293576.

Regarding claims 24,28 and 34, the subject matter claimed "a plurality of drivers,...; and a multiplexer..." has been disclosed in the claim 8 in the copend application 09293576.

Regarding claims 31 and 37, the subject matter claimed "the memory device is a BIOS memory" has been disclosed in the 13 in the copend application 09293576.

### **Claim Rejections - 35 USC § 102**

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

6. Claims 19-21,23-29,32-35 are rejected under 35 U.S.C. 102(e) as being anticipated by Kobashi et al., U.S. Patent 6031782.

Regarding claims 19, 26 and 32, Kobashi et al. teach a memory device coupled with the processor (col.2, lines 24-27), the memory device comprising a plurality of different interfaces to operate the memory device in a plurality of different modes (see abstract and col.6, lines 29 to col.8, lines 5).

Regarding claims 20, 27 and 33, Kobashi et al. teach a configuration device to select among the plurality of different interfaces is taught as selecting the interface circuit which takes in the internal signal of control circuit 123 in accordance with a specific mode (Fig.1 and 2, col.6, lines 30-32).

Regarding claims 21, 25, 29 and 35, Kobashi et al. teach the plurality of different interfaces comprises:

a test interface to test the memory device for defects is taught as a semiconductor memory device includes a mode detecting circuit for detecting designation of a specific mode in response to an externally applied mode designating signal, and issuing a corresponding mode trigger signal as a result of the detection (col.3, lines 65 to col.4, lines 2).

a programming interface to program the memory device with a code is taught as the memory cells in memory cell array are automatically refreshed based on the internal address signal generated by the self-refresh counter.

an operation interface to operate the memory device in an operation mode (col.5, lines 35-65).

Regarding claims 24, 28 and 34, Kobashi et al. teach the configuration device comprises:

a plurality of drivers, each of the plurality of drivers coupled between a device pad and a device circuit, each of the plurality of drivers having a control input (Fig.12, col.1, lines 35 to col.2, lines 4); and

a multiplexer coupled to the control input of each of the plurality of drivers to select one of the plurality of drivers (col.2, lines 5-19).

Regarding claim 23, Kobashi et al. teach the operation interface is a proprietary interface (col.6, lines 32-37).

### **Claim Rejections - 35 USC § 103**

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 22, 30-31 and 36-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobashi et al., U.S. Patent 6031782.


Regarding claims 22, 30-31 and 36-37, Kobashi et al. teach the limitations in the claims above. However, Kobashi does not teach the memory device is a flash memory and BIOS memory. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the memory device as the BIOSs which store on a flash memory chip that can be upgraded via software. This would have motivated one of ordinary skill in the art to use flash memory chip in a PC so that the BIOS could be updated in place instead of being replaced.

### Conclusion

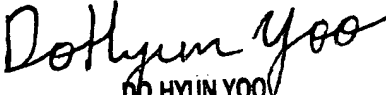
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jasmine Song whose telephone number is 703-305-7701. The examiner can normally be reached on 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Do H Yoo can be reached on 703-308-4908. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-9731 for regular communications and 703-305-9731 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Jasmine Song   
Patent Examiner

October 31, 2001

  
DO HYUN YOO  
SUPERVISORY PATENT EXAMINER  
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